



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,082	10/05/2005	Garry Pairaudeau	06275-472US1 101017-1P US	8802
26164 7590 01/07/2010 FISH & RICHARDSON P.C. P.O BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER YOUNG, SHAWQUA	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 01/07/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/552,082	PAIRAUDEAU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SHAWQUIA YOUNG	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,12-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,12,13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 4,14 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-4, 6-8, 12-14 and 16-19 are currently pending in the instant application. Claims 1-3, 6-8, 12, 13 and 16-18 are rejected and claims 4, 14, and 19 are objected in this Office Action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2009 has been entered.

#### **I. *Response to Arguments/Remarks***

Applicants have filed a RCE on September 30, 2009 with an IDS which contained a copending application that claims similar compounds as the instant claims and will be used in an ODP rejection which will be discussed in further detail below.

#### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on September 30, 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### III. ***Rejection(s)***

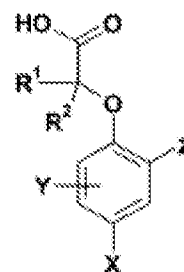
#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6-8, 12, 13 and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10-20 of copending US application 10/551,783. This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

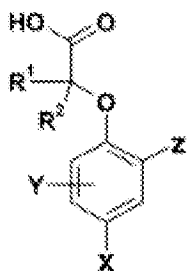


Applicants' elected subject matter is a compound of formula

wherein all variables are as defined in claim 1.

Determining the Scope and Content of the Copending Application

Claim 1 of the copending application claims a compound of the formula



, wherein X is halogen, cyano, nitro,  $S(O)_nR^6$  or  $C_{1-4}$ alkyl which is substituted by one or more halogen atoms; Y is selected from hydrogen, halogen, CN, nitro,  $SO_2R^3$ ,  $OR^4$ ,  $SR^4$ ,  $SOR^3$ ,  $SO_2NR^4R^5$ ,  $CONR^4R^5$ ,  $NR^4R^5$ ,  $NR^6SO_2R^3$ ,  $NR^6CO_2R^6$ ,  $NR^6COR^3$ , C2-C6 alkenyl, C2-C6 alkynyl, C3-C7 cycloalkyl or C1-6alkyl, the latter four groups being optionally substituted by one or more substituents independently selected from halogen,  $OR^6$  and  $NR^6R^7$ ,  $S(O)_nR^6$ ; n is 0, 1 or 2; Z is aryl or a ring A, where A is a six membered heterocyclic aromatic ring containing one or more nitrogen atoms or may be a 6,6 or 6,5 fused bicycle containing one or more O, N, S atoms, the aryl or A rings all being optionally substituted by one or more substituents independently selected from hydrogen, halogen, CN, OH, SH, nitro,  $COR^9$ ,  $CO_2R^6$ ,  $SO_2R^9$ ,  $OR^9$ ,  $SR^9$ ,  $SOR^9$ ,

Art Unit: 1626

$\text{SO}_2\text{NR}^{10}\text{R}^{11}$ ,  $\text{CONR}^{10}\text{R}^{11}$ ,  $\text{NR}^{10}\text{R}^{11}$ ,  $\text{NHSO}_2\text{R}^9$ ,  $\text{NR}^9\text{SO}_2\text{R}^9$ ,  $\text{NR}^6\text{CO}_2\text{R}^6$ ,  $\text{NHCOR}^9$ ,  $\text{NR}^9\text{COR}^9$ ,  $\text{NR}^6\text{CONR}^4\text{R}^5$ ,  $\text{NR}^6\text{SO}_2\text{NR}^4\text{R}^5$ , aryl, heteroaryl, C2-C6 alkenyl, C2-C6 alkynyl, C3-C7 cycloalkyl or C1-6alkyl, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, C3-C7 cycloalkyl,  $\text{OR}^6$ ,  $\text{NR}^6\text{R}^7$ ,  $\text{S(O)}_n\text{R}^6$ ,  $\text{CONR}^6\text{R}^7$ ,  $\text{NR}^6\text{COR}^7$ ,  $\text{SO}_2\text{NR}^6\text{R}^7$  and  $\text{NR}^6\text{SO}_2\text{R}^7$ ;  $\text{R}^1$  and  $\text{R}^2$  independently represent a hydrogen atom, halogen, C2-C6 alkenyl, C2-C6 alkynyl, C3-C7 cycloalkyl or a C1-6alkyl group, the latter four groups being optionally substituted by one or more substituents independently selected from halogen, C3-C7 cycloalkyl,  $\text{NR}^6\text{R}^7$ ,  $\text{OR}^6$ ,  $\text{S(O)}_n\text{R}^6$  ;

or

$\text{R}^1$  and  $\text{R}^2$  together can form a 3-8 membered ring optionally containing one or more atoms

selected from O, S,  $\text{NR}^6$  and itself optionally substituted by one or more C1-C3 alkyl or halogen;

$\text{R}^3$  represents C3-C7 cycloalkyl or C1-6alkyl which may be optionally substituted by one or more

substituents independently selected from halogen, C3-C7 cycloalkyl,  $\text{OR}^6$  and  $\text{NR}^6\text{R}^7$ ,  $\text{S(O)}_n\text{R}^6$ ,  $\text{NR}^6\text{COR}^7$ ,  $\text{SO}_2\text{NR}^6\text{R}^7$  and  $\text{NR}^6\text{SO}_2\text{R}^7$ ;

$\text{R}^4$  and  $\text{R}^5$  independently represent hydrogen, C3-C7 cycloalkyl or C1-6alkyl, the latter two groups

being optionally substituted by one or more substituents independently selected from halogen,

Art Unit: 1626

C3-C7 cycloalkyl,  $OR^6$  and  $NR^6R^7$ ,  $S(O)_nR^6$ ,  $NR^6COR^7$ ,  $SO_2NR^6R^7$  and  $NR^6SO_2R^7$ ;

or

$R^4$  and  $R^5$  together with the nitrogen atom to which they are attached can form a 3-8 membered saturated heterocyclic ring optionally containing one or more atoms selected from O,  $S(O)_n$ ,  $NR^8$ , and itself optionally substituted by halogen or C1-3 alkyl;

$R^6$  and  $R^7$  independently represents a hydrogen atom or C1-C6 alkyl;

$R^8$  is hydrogen, C1-4 alkyl,  $-COCl$ -C4 alkyl,  $CO_2Cl$ -C4alkyl or  $CONR^6Cl$ -C4alkyl;

$R^9$  represents aryl, heteroaryl, C3-C7 cycloalkyl or Cl-6alkyl, the latter two groups may be optionally substituted by one or more substituents independently selected from halogen, C3-C7 cycloalkyl, aryl, heteroaryl,  $OR^6$  and  $NR^6R^7$ ,  $S(O)_nR^6$ ,  $NR^6COR^7$ ,  $SO_2NR^6R^7$  and  $NR^6SO_2R^7$ ,

$R^{10}$  and  $R^{11}$  independently represent aryl or heteroaryl, hydrogen, C3-C7 cycloalkyl or Cl-6alkyl, the latter two groups being optionally substituted by one or more substituents independently selected from halogen, C3-C7 cycloalkyl, aryl, heteroaryl,  $OR^6$  and  $NR^6R^7$ ,  $S(O)_nR^6$ ,  $NR^6COR^7$ ,  $SO_2NR^6R^7$  and  $NR^6SO_2R^7$ ;

or

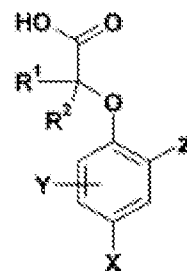
$R^{10}$  and  $R^{11}$  together with the nitrogen atom to which they are attached can form a 3-8 membered saturated heterocyclic ring optionally containing one or more atoms selected from O,  $S(O)_n$ ,  $NR^8$ , and itself optionally substituted by halogen or Cl-C3 alkyl.

The copending application claims various species in claim 8 such as [[5-Chloro-4'-(ethylsulfonyl)-6-methyl[1,1'-biphenyl]-2-yl]oxy]acetic acid.

Ascertaining the Differences Between the Instant Application and the Copending Application

The difference between the instant compounds and the compounds in the copending application is the placement of the substituents (variables X and Y) on the ring system.

Finding Prima Facie Obviousness



Applicants' are claiming compounds of the formula wherein X can be C<sub>1-6</sub> alkyl wherein all other variables are as defined in claim 1. The copending application claims similar compounds wherein the C<sub>1-6</sub> alkyl is in a different position on the phenyl ring (i.e, 6-position) in claim 1 of the copending application and claims specific compounds in claim 8 such as [[5-Chloro-4'-(ethylsulfonyl)-6-methyl[1,1'-biphenyl]-2-yl]oxy]acetic acid. For example, the compound [[5-Chloro-4'-(ethylsulfonyl)-6-methyl[1,1'-biphenyl]-2-yl]oxy]acetic acid only differs from the instant compounds because the methyl group is at the six position instead of the 5-position (variable X) and the chloro group is at the 5-position instead of the 6-position (Y variable). It was established in In re Jones, 162 F. 2d 638, 74 USPQ 152 (CCPA 1947), that compounds



Art Unit: 1626

which differ only in the placement of substituents in a ring system is not patentable absent unexpected results. Therefore, it would have been obvious for one of ordinary skill in the art to prepare similar compounds as claimed in the copending application by modifying the placement of the substituents on the phenyl ring with a reasonable expectation of success. Therefore, the instant claims are rejected under obvious double patenting.

#### **IV.    *Objections***

##### **Dependent Claim Objections**

Dependent Claims 4, 14, and 19 are objected to as being dependent upon a rejected based claim. To overcome this objection, Applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim.

#### **V.    *Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626